REMARKS / ARGUMENTS

Claims 1, 29-32, and 35 have been amended; Claims 2-4 and 6-8 have been canceled, without prejudice or disclaimer; Claims 18-26 have been withdrawn; and new Claims 38-55 have been added; therefore, Claims 1, 5, and 9-55 are pending, of which Claims 18-26 have been withdrawn from consideration. Applicants have carefully considered the application in view of the Examiner's action and, in light of the foregoing amendments and the following remarks, respectfully request reconsideration and full allowance of all pending claims.

As a preliminary matter, it is noted that the name of the first named inventor is spelled Woodrow W. Gandy, as indicated on the Declaration and Assignment, not Woodrow W. Grandy as incorrectly indicated on the filing receipt and Office action. It is respectfully requested that the spelling of the first named inventor be corrected in the records of the Patent and Trademark Office.

As a further preliminary matter, it is noted that some of the amendments to Claims 1, 29-32, and 35 have been effectuated to correct minor typographical and grammatical errors, without adding any new matter to the application as originally filed. In other instances, Claims 1, 29-32, and 35 have been amended to clarify that it is not required that a user be a health care professional, as supported by original Claims 1 and 29, thereby adding no new matter to the application.

Applicant's Declaration under 37 CFR 1.132 has been deemed not effective for various reasons. In response, Applicants have generally updated, and specifically amended the preamble and paragraphs 8 and 15 of, the Declaration to overcome the cited objections, and respectfully request that the objections to same be withdrawn.

Claims 1, 5, 9-14, and 35-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Pub. No. US 2001/0029322 to Iliff (hereinafter "*Iliff*") in view of U.S. Patent No. 6,154,726 to Rensimer et al. (hereinafter "*Rensimer*"). Claims 15-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Iliff* and *Rensimer*, and further in view of U.S. Patent No. 6,871,140 to Florance et al. (hereinafter "*Florance*"). Claims 27-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Iliff, Rensimer*, and further in view of U.S. Patent Pub. No. US 2002/0002502 to Maes et al. (hereinafter "*Maes*"). In response, Applicants respectfully traverse.

More specifically, *Iliff* has been cited as fully disclosing Applicant's invention as recited in Claim 1, but for explicitly disclosing "entering data obtained by a health care professional by observation, testing, examination" for which *Rensimer* has been cited. *Iliff*, however, also fails to either teach or suggest templates, inquiries, sub-templates, or modifiers <u>selected by a user</u> for response. The Examiner has cited paragraphs 0032, 0035, 0060, 0136, 0703-0705, 0721, 0274-0285, and Fig. 32, item 2592, of *Iliff* as teaching the capacity to select a template. However, upon closer examination, it is apparent that pars. 0032 and 0035 by themselves are unclear regarding <u>who</u> or <u>what</u> selects portions of MDATA, scripts, or medical algorithms for presentation to a user. To determine that, one must look to paragraph 0060 which refers to Fig. 23 (par. 0478 ff.) which is a <u>menu-driven</u> treatment selection process; that is, a process wherein a user responds to a question in a menu, and <u>based on the response to the question, a *computer* selects one or more further questions to ask</u>, or proposes a diagnosis or treatment for the user. Paragraph 0136 is even more clear on the issue, asserting that:

> "The course of an algorithm is determined by caller responses to questions that the MDATA system asks. For simple "yes/no" questions, the flow of interaction can be described by a binary tree. Multiple-choice questions (e.g., menus) provide multiple branches in the tree. Each question can be considered a node, and the acceptable responses to this question are branches leading to the next question (node). Using this abstraction of an algorithm, one can draw a directed graph (also known as a node map) of the nodes and branches of an algorithm, beginning with the initial question, and ending with all possible terminal points."

Paragraphs 0703-0705 disclose the entry of information related to a user's medical condition, but <u>not</u> the selection of a template through which to enter such information. Paragraph 0721 not only fails to cure this deficiency, but teaches that after a patient fills in a form, MDATA analyzes the response and selects the next page to send (see also Fig. 29, item 2412). Paragraphs 0274-0285 teach more diagnosis, such as how to diagnose someone that may be in "altered state of consciousness" and teaches the use of a "mental status examination" to assess a patient's orientation, which gives one pause to wonder how a user may select a template to use if such user is not even competent to fill in a template once it is presented. Finally, Fig. 32, item 2592, teaches that a form is sent to a user subsequent to execution of an algorithm,

or script (paragraph 0732), but there is no teaching or suggestion that a user selects which form to execute.

Iliff is clearly in contrast to Applicant's invention, as recited in Claim 1 as amended, wherein a <u>user selects a template or a sub-template having one or more inquiries</u> (*i.e.*, questions), and then the <u>user (*not* a computer) selects which inquiries (*i.e.*, questions) to respond to</u>.

Iliff also fails to teach or suggest data entry by at least one of observation, testing and examination of a patient by a user, for which *Rensimer* was cited. The Examiner has noted in particular that *Rensimer* is a "system and method that permits physicians and other medical staff personnel to record, accurately and precisely, the <u>treatment</u> and <u>care</u> given in a particular patient encounter" (emphasis added). *Rensimer*, however, fails to teach or even suggest recording a <u>medical condition</u>, as claimed by Applicants in Claim 1. To the contrary, *Rensimer* is limited to recording <u>treatment</u> and <u>care</u> given to a patient, particularly data relating to treatment and care which is necessary for administrative purposes, billing, and insurance claims.

Furthermore, there is no teaching or suggestion in either *Iliff* or *Rensimer* to combine the two patents, as is required to support a rejection under 35 U.S.C. § 103(a). Even if there were such a teaching or suggestion, it is not at all clear <u>how</u> *Iliff* and *Rensimer* could be meaningfully combined, other than as two essentially separate, disparate programs packaged together, as could be done with any two programs, though without being meaningfully integrated together. Even if, for the sake of argument, *Iliff* and *Rensimer* could be meaningfully combined, because the two programs are so disparate, there is no feature of one program that the other program does better, and hence no motivation to make such a combination. Still further, *Iliff* is directed to the general public (par. 0013), but *Rensimer* is clearly directed to medical professionals, such as doctors and nurses, further bringing into question what motivation there would be to combine the patents. Because motivation is also required to combine patents in support of a rejection under 35 U.S.C. § 103(a), it is respectfully submitted that it is <u>improper</u> to combine *Rensimer* with *Iliff*, and it is thus requested that the rejection of Claim 1 under 35 U.S.C. § 103(a) as being unpatentable over *Iliff* in view *Rensimer*, be withdrawn.

Still further, *Iliff* fails to teach or suggest a language program configured for producing a text report based on data entered by the user into the templates and sub-templates <u>selected by the user</u>, wherein the report utilizes modifiers to summarize the data. The language program

allegedly taught by *Iliss* is cited by the Examiner at pars. 0343-0035, 0125, 0204, 0701-0702 and Fig. 3, items 170 and 172. In response, Applicants first note that it is unclear which paragraphs are being referenced by 0343-0035. If paragraph 0343, then that comprises a table of first letters of meta string parameters, the relevance of which is unclear. Similarly, the relevance is unclear of paragraph 0125, relating to "E-codes", and paragraph 0204, relating to medical conditions not expected to change. Paragraphs 0701-0702 discuss program languages, not a language program, and the program languages are <u>not</u> adapted for producing text reports. Items 170 and 172 of Fig. 3 (pars. 0130-0156) discuss a language program for authoring and encoding medical knowledge and questions into the MDATA system, <u>not</u> for producing a text report <u>based on answers from a user to the questions, or based on data entered by the user into the templates and sub-templates selected by the user,</u> much less such a report that utilizes modifiers to summarize the data.

In view of the foregoing, it is apparent that none of the cited references, either singularly or in any combination, teach, suggest, or render obvious the unique combination now recited in independent Claim 1. It is therefore respectfully submitted that Claim 1 clearly and precisely distinguishes over the cited combinations of references in a patentable sense, and is therefore allowable over those references and the remaining references of record. Accordingly, it is respectfully requested that the rejection of Claim 1 under 35 U.S.C. § 103(a) as being unpatentable over *Iliff* in view *Rensimer*, be withdrawn.

Claim 29 has been amended as a method claim in a manner analogous to that of system Claim 1, and is thereby supported by Claim 1, without adding any new matter to the application. Furthermore, Claims 29 and 35 are an independent method and computer program product claims, respectively, analogous to the system recited in independent Claim 1, thereby having limitations corresponding to the limitations of Claim 1. For the reasons set forth above, Claims 29 and 35 are therefore also deemed to be in condition for allowance, and it is respectfully requested that the rejection of independent Claims 29 and 35 under 35 U.S.C. § 103(a) as being unpatentable over *Iliff* in view *Rensimer* and *Maes*, be withdrawn, as well.

Claims 5, 9-17, 27, 28, 30-32, 36, and 37 depend from and further limit independent Claims 1, 29, and 35 in a patentable sense, and, for this reason and the reasons set forth above, are also deemed to be in condition for allowance. Accordingly, it is respectfully requested that the rejections of dependent Claims 5, 9-17, 27, 28, 30-32, 36, and 37 be withdrawn, as well.

New Claims 38-55 are supported by Claims 18-26 as originally filed, and paragraphs 0062-0074 and Figs. 34-37 of the specification as originally filed, and therefore add no new matter to the application. For this reason and the reasons set forth above, Claims 38-55 are also deemed to be in condition for allowance.

Attached is a Petition for Extension of Time, along with authorization to charge the 37 C.F.R. § 1.17(a) fee for a two (2) month extension of time.

By this amendment, Claims 38 to 55 have been added, resulting in a total of 18 new dependent claims in excess of twenty claims. Accordingly, in addition to the 37 C.F.R. § 1.17(a) fee for a two (2) month extension of time, the Commissioner is authorized to charge the amount of $450.00 in payment for the 37 C.F.R. § 1.16(i) fee for adding claims in excess of twenty, and any other required fees (other than issue fees), and to credit any overpayment, made in connection with the filing of this paper, to Deposit Account No. 50-2032 of Scheef & Stone, L.L.P.

Applicant has now made an earnest attempt to place this application in condition for allowance, or *in better condition for appeal*. Therefore, Applicant respectfully requests, for the reasons set forth herein and for other reasons clearly apparent, full allowance of Claims 1, 5, 9-17, and 27-55 so that the application may be passed to issue.

Should the Examiner have any questions or desire clarification of any sort, or deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the number listed below.

Respectfully submitted,

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